



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,348	11/17/2000	Erik D. Kokkonen	9837-009-999	6330

24341 7590 07/09/2004

MORGAN, LEWIS & BOCKIUS, LLP.
3300 HILLVIEW AVENUE
PALO ALTO, CA 94304

EXAMINER

LE, MIRANDA

ART UNIT PAPER NUMBER

2177

DATE MAILED: 07/09/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,348

Applicant(s)

KOKLEONEN, ERIC

Examiner

Miranda Le

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2177

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/06/2004 has been entered.

This communication is responsive to Amendment C, filed 04/06/2004.

2. Claims 1-48 are pending in this application. Claims 1, 7, 8, 14, 15, 21, 22, 26, 29, 34-36, are independent claims. In the Amendment C, claims 1, 5-8, 12-15, 19-22, 25-26, 28, 29, 31, 34-36 have been amended, claims 37-48 have been added, and no claims have been cancelled. This action is made non-Final.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless:

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2177

4. Claims 1-23, 25-31, 34-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan et al. (US Patent No. 6,421,675).

Ryan anticipated independent claims 1, 7, 8, 14, 15, 21, 22, 26, 29, 34-36 by the following:

As to claims 1, 8, 15, Ryan teaches “a method of generating directed content...receiving a set of lists from a plurality of remote web services that are adapted to receive submissions of at least one search term and perform a search for the search term submitted, each list in said set of lists being associated with, and maintained by, the respective web service, each list in said set of lists including search terms submitted to said respective web service that were used by said respective web service to perform searches” at col. 6, lines 9-24, col. 21, lines 14-27, col. 12, lines 44-60, Fig. 6-Table 3;

“distilling said set of lists into a frequency database, the database storing search frequency information indicating, for respective search terms, a frequency with which each of the search terms were submitted to each of one or more of the plurality of remote web services for searching by the respective remote web service” at col. 12, lines 1-14, col. 11, line 58 to col. 12, line 15, col. 6, lines 9-24, col. 21, lines 14-27, Fig. 6-Table 2;

“obtaining a query” at col. 11, lines 18-54;

“searching the frequency database for matches between said query and search terms in the database, the matches indicating that the obtained query was submitted as a search term to each of the one or more of the plurality of remote web services” at col. 11, lines 18-54;

Art Unit: 2177

“selecting the matches having highest associated frequencies, each selected match indicating a respective selected remote web service” at col. 24, lines 7-31, col. 21, line 49 to col. 22, line 19;

“generating directed content based on one or more of the selected web services so that the directed content is generated based on the remote web services ” at col. 24, lines 7-31, col. 21, line 49 to col. 22, line 19.

As to claims 7, 14, 21, Ryan teaches “a method of generating directed content, the method comprising: receiving a plurality of lists from a plurality of remote web services that are adapted to receive submissions of at least one search term and perform a search for the search term submitted, each list in said plurality of lists being associated with, and maintained by, the respective web service, each list in said plurality of lists including the search terms submitted to said respective web service that were used by said respective web service to perform searches” at col. 6, lines 9-24, col. 21, lines 14-27, col. 12, lines 44-60, Fig. 6-Table 3;

“distilling said plurality of lists into a frequency sorted list, the frequency sorted list including a plurality of entries, each entry having a search term and a number of times said search was submitted to a respective web service for searching by the respective remote web service” at col. 11, line 58 to col. 12, line 15, col. 6, lines 9-24, col. 21, lines 14-27, Fig. 6-Table 2;

“obtaining a query” at col. 11, lines 18-54;

Art Unit: 2177

“searching the frequency sorted list for matches between said query and a search term in the frequency sorted list, the matches indicating that the query was submitted as a search term to the respective remote web service” at col. 11, lines 18-54;

“selecting the matches having highest associated frequencies, each selected match indicting a respective selected remote web service of the web services” at col. 24, lines 7-31, col. 21, line 49 to col. 22, line 19;

“generating directed content based on one or more of the selected remote web services so that the directed content is generated based on the remote web services having the highest associated frequencies for the obtained query” at col. 24, lines 7-31, col. 21, line 49 to col. 22, line 19.

As to claims 22, 26, 29, Ryan teaches “a method of generating a directed advertisement, the method comprising: obtaining a query” at col. 11, lines 18-54;

“searching a web resource for a match between said query and an element of said web resource” at col. 11, lines 18-54;

“selecting a remote web service based on said element of said web resource” at col. 24, lines 7-31;

“routing said query to an instance of said selected web service” at col. 21, lines 14-49;

“collecting data generated by said selected remote web service in response to said query” at col. 23, lines 33-58;

“generating said directed advertisement, said directed advertisement including a portion of said response within said advertisement” see Fig. 2.

Art Unit: 2177

As to claims 34, 35, 36, Ryan teaches “a method of generating a directed advertisement, the method comprising: obtaining a query” at col. 11, lines 18-54;

“selecting a remote web service based on said query” at col. 11, lines 18-54;

“routing said query to an instance of said selected remote web service” at col. 21, lines 14-49;

“collecting data generated by said selected remote web service in response to said query” at col. 23, lines 33-58;

“generating said directed advertisement, said directed advertisement including a portion of said response within said advertisement” see Fig. 2.

As to claims 2, 9, 16, Ryan teaches “directed content is a link to a web service that was selected during said searching step” at col. 6, lines 7-67.

As to claims 3, 10, 17, Ryan teaches “identifying a category that corresponds to a selected web service” at col. 11, lines 42-56;

“said directed content including an advertisement that corresponds to said category” see Fig. 2.

As to claims 4, 11, 18, “routing said query to an instance of a selected remote web service” at col. 21, lines 14-49;

“collecting data generated by said selected remote web service in response to said query” at col. 23, lines 33-58;

Art Unit: 2177

"wherein said advertisement includes a portion of said response" see Fig. 2.

As to claims 5, 12, 19, Ryan teaches "a match having highest associated frequency is determined by a rank of a search term, which matches said query, in a list associated with a web service in said plurality of web services" at col. 21, line 28 to col. 22, line 19.

As to claims 6, 13, 20, Ryan teaches "a match having highest associated frequency is determined by a score that is a function of (i) a rank of a search term, which matches said query, in a list associated with a web service in said plurality of web services and (ii) the logarithm of the frequency of said search term in the list" at col. 21, line 28 to col. 22, line 19.

As to claims 23, 27, 30, Ryan teaches "element of said web resource is a category" at col. 11, lines 42-56.

As to claims 25, 28, 31, Ryan teaches "said web resource is a frequency database, the database storing search frequency information indicating, for respective search terms, a frequency with respect to each of one or more of a plurality of web services to which the respective search terms were submitted" at col. 6, lines 9-24, col. 21, lines 14-27, col. 12-Table 3, Table 2;

"said element of said resource is an entry in the frequency database corresponding to said selected web service, said search frequency information stored in said frequency database indicating that a search for said search term has been conducted at said selected web service at a

Art Unit: 2177

high frequency relative to other web services of said plurality of web services” at col. 11, line 58 to col. 12, line 15, col. 12-Table 3, Table 2.

As to claims 37-48, Ryan teaches “each remote web service in said plurality of web services is a search engine” see Fig. 1A.

5. Claims 24, 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. (US Patent No. 6,487,557 B1), in view of Chris Sherman (“Google Introduces Web Directory Using Netscape’s Open Directory Project Data”).

As to claims 24, 32, 33, Ryan does not specifically teach “the web resource is Open Directory Project”. However, Sherman teaches this limitation on page 1-2.

It would have been obvious to one ordinary skilled in the art at the time of the invention was made to combine the teachings of Ryan with the teaching of Sherman to include “the web resource is Open Directory Project” in order to creates the most comprehensive and robust search resource for finding information and browsing the web.

Response to Arguments

6. Applicant's arguments regarding Nagatomo and Alberts do not teach the amended claimed limitations with respect to claims 1-48 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2177

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (703) 305-3203. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached on (703) 305-9790. The fax number to this Art Unit is (703) 872-9306. The TC 2100's Customer Service number is (703) 306-5631.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Miranda Le
June 23, 2004



GRETA ROBINSON
PRIMARY EXAMINER